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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LUONG, SHIAN TINH NHAN	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,288	Applicant(s) KUREMOTO ET AL.	
	Examiner Shian T. Luong	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/22/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,27,29-32,34-36,38-41,43-46 and 48-53 is/are rejected.
- 7) ☒ Claim(s) 28,33,37,42 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The preliminary amendment filed on 9/22/03 does not correspond to the drawing figures. This includes the amendment made to the specification regarding Figures 3,5,6,13,15,16,21,23 and 24. For example, in Figure 3, the sectional view is taken on line A and not line 3.-3. in Figure 1 because line 3.-3. does not exist in Figure 1.

Also, the proposed amendment to page 16, line 14 has not been entered because the proposed language does not correspond to the description on page 16, line 14. Applicant needs to clarify the exact paragraph for the amendment.

Claim Rejections - 35 USC § 112

2. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear which of the central portion has a height equivalent to the thickness of the case. In addition, the central portion of the holding plate has to engage the central portion of the cover and hence neither one of the central portions would be equivalent to the thickness of the case.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 26, 29, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese patent 9-226869. Japanese patent 9-226869 discloses a disc storage case having a holding plate 3 and a cover member 4 pivotally connected together. The holding plate has a holding portion 7 having a top surface which includes the top portions of the prongs. As shown in Figure 4, the cover member 4 and the top surface of the prong (extending away from the projection 11) has a clearance which is less than the thickness of the compact disk. Also in Figure 9, a clearance is between the cover member and the top surface of holding portion. Regardless whether the projection extends into the prongs or holding portion, the CD storage container still remains a clearance between the cover member and the top surface of the holding portion.
5. Claims 26, 29, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Kownacki (US 5,238,107). Kownacki discloses a disc storage case having a holding plate 12 and a cover member 14 pivotally connected together. The holding plate has a holding portion 18 having a top surface.. As shown in Figure 3, the cover member 4 and the top surface has a clearance which is less than the thickness of the compact disk.
6. Claim 27 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese patent 9-226869 or Kownacki. Figure 15 of the Japanese patent 9-226869 drawing shows the storage case having a thickness of not greater than 6mm. Figure 3 of the Kownacki drawing shows a tight fit case. But even if the case thickness is greater than 6mm, it would have been obvious to make the thickness modification through routine experiments.

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7. Claims 38-39 are rejected under 35 U.S.C. 102(b) as anticipated by Nakasuji (US 5,896,985). Nakasuji discloses a disk tray hingedly connected to a cover for storing a disk therein. Communication aperture is adjacent to the label holding claws.

8. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by Davault (US 5,613,612). Davault discloses a disk tray hingedly connected to a cover for storing a disk therein.

9. Claims 38-39 are rejected under 35 U.S.C. 102(b) as anticipated by Taniyama (US 5,515,968). Taniyama discloses a disk tray hingedly connected to a cover for storing a disk therein. Communication aperture is located adjacent to the label holding claws.

10. Claim 51 is rejected under 35 U.S.C. 102(b) as anticipated by Japanese Laid Open Patent Publication '610. Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. A plurality of recesses 41,42 is provided on the two lateral sides of the bottom seat within the wing portions of the two n-shaped walls. The recesses are formed to correspond to the semicircular tabs 64,65 on the cover. The recesses and tabs engage in such a manner that they perform the dust-proof function. The protruding piece 67 on the cover coincides with the indentation 39 on the bottom seat.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 27 and 31,32, 40,41, 44, 45,46,48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 9-226869 or Kownacki in view of Official Notice or Japanese publication 8-90610 or Clemens (4,903,829). It is conventionally known that a small, thin container or case is desired for storage or transportation purposes due to its size. An artisan in the art would readily recognize the need to make the container of a desired thickness or height to meet the shipping requirement. On the other hand, Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. The specification discloses that the container is a slim type. Clemens also teaches a container that appears to be a slim size. It would have been obvious in view of Official Notice or Japanese publication 8-90610 or Clemens to provide a

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container with a height not greater than 6mm for storage and transportation purpose and to reduce cost.

13. Claims 31,32, 34,35, 40,41, 43,44, 45,46,48,49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniyama (US 5,515,968) in view of Japanese patent 9-226869 or Kownacki and/or Japanese publication 8-90610 or Clemens (4,903,829). Taniyama discloses a storage disk with hinged cover and base. The cover has communication apertures adjacent to the holding claws. Taniyama discloses generally all of the limitations of the claims, but does not disclose the distance between the top surface of the holding portion and the rear surface of the holding plate and the space within the storage case. Japanese patent 9-226869 discloses a disc storage case having a holding plate 3 and a cover member 4 pivotally connected together. The holding plate has a holding portion 7 having a top surface which includes the top portions of the prongs. As shown in Figure 4, the cover member 4 and the top surface of the prong (extending away from the projection 11) has a clearance which is less than the thickness of the compact disk. Also in Figure 9, a clearance is between the cover member and the top surface of holding portion. Regardless whether the projection extends into the prongs or holding portion, the CD storage container still remains a clearance between the cover member and the top surface of the holding portion. Kownacki discloses a disc storage case having a holding plate 12 and a cover member 14 pivotally connected together. The holding plate has a holding portion 18 having a top surface. As shown in Figure 3, the cover member 4 and the top surface have a clearance which is less than the thickness of the compact disk. It is also conventionally known that a small, thin container or case is desired for storage or transportation purposes due to its size. An artisan in the art would readily recognize the need to make the container of a desired thickness or

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height to meet the shipping requirement. On the other hand, Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. The specification discloses that the container is a slim type. Clemens also teaches a container that appears to be a slim size. It would have been obvious in view of Japanese patent 9-226869 or Kownacki and Official Notice or Japanese publication 8-90610 or Clemens to provide a container with a height not greater than 6mm for storage and transportation purpose and to reduce cost.

14. Claims 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 31, further in view of Grobecker (US 4,805,770). Japanese patent 9-226869 or Kownacki does not disclose a hinge that allows the cover and base pivot over 180 degrees with respect to one another. But Grobecker suggests providing a cover with protruding shafts and base with two holes to engage the shafts. The cover pivots to 180 degrees as shown in Figure 15 and beyond as shown in Figure 16. The abutting portions are the side edge of the cover and base member when the two portions pivot relative to one another. One of ordinary skill in the art would apply the hinge as taught in Grobecker on the storage case of Japanese patent 9-226869 or Kownacki to allow the cover to pivot with respect to the base over 180 degrees.

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15. Claim 30, 35, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 26,31 or 41, further in view of Nakasuji (US 5,896,985) or Fraser et al (US 5,788,068). Japanese patent 9-226869 or Kownacki fails to disclose communication aperture as recited in claim 30. Nakasuji teaches a plurality of communication apertures adjacent to the label holding claws. Fraser et al. also teaches communication apertures 11A on the cover member. The apertures allow the view of the pamphlet or information sheets therein. It would have been obvious in view Nakasuji or Fraser et al. to provide the apertures on the cover member of Japanese patent 9-226869 or Kownacki to allow access to the pamphlet.

16. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 31, further in view of Japanese Laid Open Patent Publication '610. Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. A plurality of recesses 41,42 is provided on the two lateral sides of the bottom seat within the wing portions of the two n-shaped walls. The recesses are formed to correspond to the semicircular tabs 64,65 on the cover. The recesses and tabs engage in such a manner that they perform the dust-proof function. The protruding piece 67 on the cover coincides with the

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indentation 39 on the bottom seat. It would have been obvious in view of Japanese '610 to provide the corresponding tabs and protrusion on the cover to properly engage the indentation on the base of Japanese patent 9-226869 or Kownacki.

17. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 31, further in view of Japanese Laid Open Patent Publication '610. Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. A plurality of recesses 41,42 is provided on the two lateral sides of the bottom seat within the wing portions of the two n-shaped walls. The recesses are formed to correspond to the semicircular tabs 64,65 on the cover. The recesses and tabs engage in such a manner that they perform the dust-proof function. The protruding piece 67 on the cover coincides with the indentation 39 on the bottom seat. It would have been obvious in view of Japanese '610 to provide the corresponding tabs and protrusion on the cover to properly engage the indentation on the base of Taniyama.

18. Claims 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Japanese patent 9-226869 or Kownacki in view of Japanese Laid Open Patent Publication '610. Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection

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molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. A plurality of recesses 41,42 is provided on the two lateral sides of the bottom seat within the wing portions of the two n-shaped walls. The recesses are formed to correspond to the semicircular tabs 64,65 on the cover. The recesses and tabs engage in such a manner that they perform the dust-proof function. The protruding piece 67 on the cover coincides with the indentation 39 on the bottom seat. It would have been obvious in view of Japanese '610 to provide the corresponding tabs and protrusion on the cover to properly engage the indentation on the base of Japanese patent 9-226869 or Kownacki.

19. Claims 50-51,53 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Taniyama in view of Japanese Laid Open Patent Publication '610. Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. A plurality of recesses 41,42

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is provided on the two lateral sides of the bottom seat within the wing portions of the two n-shaped walls. The recesses are formed to correspond to the semicircular tabs 64,65 on the cover. The recesses and tabs engage in such a manner that they perform the dust-proof function. The protruding piece 67 on the cover coincides with the indentation 39 on the bottom seat. It would have been obvious in view of Japanese '610 to provide the corresponding tabs and protrusion on the cover to properly engage the indentation on the base of Taniyama.

20. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 51, further in view of Official Notice or Japanese publication 8-90610 or Clemens (4,903,829). It is conventionally known that a small, thin container or case is desired for storage or transportation purposes due to its size. An artisan in the art would readily recognize the need to make the container of a desired thickness or height to meet the shipping requirement. On the other hand, Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. The specification discloses that the container is a slim type. Clemens also teaches a container that appears to be a slim size. It would have been obvious in view of Official Notice or Japanese publication 8-90610 or Clemens to provide a container with a height not greater than 6mm for storage and transportation purpose and to reduce cost.

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21. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 51, further in view of Nakasuji (US 5,896,985) or Fraser et al (US 5,788,068). Japanese patent 9-226869 or Kownacki as modified above fails to disclose communication aperture as recited in claim 53. Nakasuji teaches a plurality of communication apertures adjacent to the label holding claws. Fraser et al. also teaches communication apertures 11A on the cover member. The apertures allow the view of the pamphlet or information sheets therein. It would have been obvious in view Nakasuji or Fraser et al. to provide the apertures on the cover member of Japanese patent 9-226869 or Kownacki to allow access to the pamphlet.

22. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 51, further in view of Japanese patent 9-226869 or Kownacki and/or Japanese publication 8-90610 or Clemens (4,903,829). Taniyama discloses generally all of the limitations of the claims, but does not disclose the thickness of the case. Japanese patent 9-226869 discloses a disc storage case having a holding plate 3 and a cover member 4 pivotally connected together. The holding plate has a holding portion 7 having a top surface which includes the top portions of the prongs. As shown in Figure 4, the cover member 4 and the top surface of the prong (extending away from the projection 11) has a clearance which is less than the thickness of the compact disk. Also in Figure 9, a clearance is between the cover member and the top surface of holding portion. Regardless whether the projection extends into the prongs or holding portion, the CD storage container still remains a clearance between the cover member and the top surface of the holding portion. Kownacki discloses a disc storage case having a holding plate 12 and a cover member 14 pivotally connected together. The holding plate has a holding portion 18 having a top surface. As shown in Figure 3, the cover member 4

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and the top surface have a clearance which is less than the thickness of the compact disk. It is also conventionally known that a small, thin container or case is desired for storage or transportation purposes due to its size. An artisan in the art would readily recognize the need to make the container of a desired thickness or height to meet the shipping requirement. On the other hand, Japanese Laid Open Patent Publication '610 discloses a low-profile compact disk case made by injection molding comprising a top cover 32 and a bottom seat 31 pivotally connected to each other at pivotal edges thereof to provide an inner space for receiving a compact disk therein. The slim type CD case including an inner surface, a central holding means 46, a plurality of protective means 45 and a bottom seat integrally formed on the inner surface. The central holding means 46 is a short hollow cylinder extending upwardly from the bottom seat and having spaced cuts along a circumferential wall to provide a plurality of flexible catch pawls. The specification discloses that the container is a slim type. Clemens also teaches a container that appears to be a slim size. It would have been obvious in view of Japanese patent 9-226869 or Kownacki and Official Notice or Japanese publication 8-90610 or Clemens to provide a container with a height not greater than 6mm for storage and transportation purpose and to reduce cost.

Allowable Subject Matter

23. Claims 28,33,37,42,47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion


24. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. **The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648.**

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the official FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL
May 10, 2004


Primary Examiner
Shian Luong
Art Unit 3728